

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

REMARKS

1. Posture of the case

Claims 1 through 9 were originally presented in the application. After a first Office action and reply, in which no claims were amended, all the claims were finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,609,151 ("Khanna") in view of U.S. Patent 6,457,879 ("Thurlow"). Office action, March 19, 2004 (the "Final Office Action"). Office action, March 19, 2004 (the "Final Office Action"). Appellant appealed from the final rejection and filed an Appeal Brief with no amendments to the claims. Appeal Brief, August 21, 2004; see also Correction to Appeal Brief, September 20, 2004 (correcting a citation and correcting the basis of the rejection in the Final Office Action, which was 35 U.S.C. 103).

A draft amendment was submitted responsive to a telephone discussion initiated by Examiner Tran on October 29, 2004, in which the Examiner indicated the claims would be allowable if certain features stated in the preambles of the independent claims were placed in the bodies of the claims, and if certain formatting was corrected with regard to hyphens and commas. The draft amendment stated the certain features in the bodies of the claims instead in the preambles of the claims and corrected the certain formatting with regard to hyphens and commas, as requested. However, the indicated allowance did not follow. Instead, the current Office action ensued. Office action, December 15, 2004 (the "Present Office Action").

The Present Office Action maintains the rejection of all claims under 35 U.S.C. 103(a), with reliance upon Khanna in view of Thurlow. In addition, the Present Office Action objects to informalities in all the independent claims, i.e., claims 1, 4 and 7. Also the Present Office Action rejects all the independent claims under 35 U.S.C. 112, both first and second paragraphs.

2. Informalities

Amendments are submitted herein to correct the informalities pointed out in the Present Office Action. Specifically, in claim 1 "the said remote email server" is amended to read "the remote email server." And hyphens are deleted in claims 1, 4 and 7. Applicant contends this corrects the informalities.

3. Rejections under 35 U.S.C. 112, second paragraph

Amendments are submitted herein to correct lack of antecedent basis pointed out in the Present Office Action. Specifically, the Present Office Action rejects the following:

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

a. Claim 1

The Present Office Action states that there is no antecedent basis for "the boot up process" in "a means to access the said remote email server through network during the boot up process." The claim is responsively amended herein to move "a basic input/output system (BIOS) for booting" from the preamble of the claim to the body of the claim. Also, the element in the body of the claim is amended to state that the BIOS is "for booting *the computing system*" (emphasis added) to provide a clearer basis for later reference. No new matter is added, since the specification provides support for the amendment. Present application, page 4, line 16 - page 5, line 2 and FIG's 1 and 2 (describing and illustrating BIOS booting a computer system). See also the remarks herein below regarding BIOS operations in connection the rejection under 35 U.S.C. 103(a) and corresponding amendments. Also, the claim is further amended to state "during the booting of the computing system" (instead of "during the boot up process"). Applicant contends this overcomes the rejection.

The Present Office Action states that there is no antecedent basis for "the email count" and "the current user" in "a means to download the email count for the current user." This is responsively amended herein to state that the communicating means downloads email headers and that the BIOS includes "means for parsing the email headers . . . to extract *an* email count for *a* user." (emphasis added). Applicant contends this overcomes the rejection. See remarks herein below, regarding rejections under 35 U.S.C. 103(a), for discussion of support in the disclosure for the changes regarding headers, parsing and extracting

The Present Office Action states that there is no antecedent basis for "the display" in "a means to display the email count for the current user in a defined format on the display of said computing system." The claim is responsively amended herein to delete "on the display of the computing system." Applicant contends this overcomes the rejection.

Other amendments to claim 1 are discussed herein below along with remarks regarding rejections under 35 U.S.C. 103(a).

b. Claim 3

The Present Office Action states that there is no antecedent basis for "the designated users" in "configuration means for configuring the designated users." This is responsively amended herein to read "configuration means for configuring users." Applicant contends this

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

overcomes the rejection. Other amendments to claim 3 are discussed herein below along with remarks regarding rejections under 35 U.S.C. 103(a).

c. Claim 4

The Present Office Action states that there is no antecedent basis for "the boot up process" in "a method for accessing email count during the boot up process." This is responsively amended herein to read "a method for accessing email count during *booting of the computing system.*" (emphasis added). Applicant contends this overcomes the rejection.

The Present Office Action states that there is no antecedent basis for "the email count" and "the user" in "downloading the email count for the user." This is responsively amended herein in similar fashion as the amendments discussed above regarding claim 1. Applicant contends this overcomes the rejection.

The Present Office Action states that there is no antecedent basis for "the current user" and "the display" in "displaying the email count for the current user in a defined format on the display of said computing system." The preamble to the claim is herein responsively amended to state that the computing system includes a display. With this amendment and the amendment described immediately above, there is antecedent basis in the "displaying an email count" step later in the claim for the reference to "the user" and "the display." Applicant contends this overcomes the rejection.

Other amendments to claim 4 are discussed herein below along with remarks regarding rejections under 35 U.S.C. 103(a).

d. Claim 6

The Present Office Action states that there is no antecedent basis for "the designated users" in "configuring the designated users of the system during a previous operation." This is responsively amended herein to delete the "the designated" before "users." Applicant contends this overcomes the rejection.

Other amendments to claim 6 are discussed herein below along with remarks regarding rejections under 35 U.S.C. 103(a).

e. Claim 7

The Present Office Action states that there is no antecedent basis for "the boot up process" in "to access email count during the boot up process." This is responsively amended

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

herein to read "to access *an* email count during booting of the computing system" (emphasis added). Applicant contends this overcomes the rejection. Also, "computer" is herein amended to read "computing system," for consistency.

The Present Office Action states that there is no antecedent basis for "the network adapter" in "computer readable program code means configured for communicating with the network adapter." This is responsively amended herein to read "computer readable program code means configured for communicating with *a* network adapter" (emphasis added). Applicant contends this overcomes the rejection.

The Present Office Action states that there is no antecedent basis for "said remote email server" in "computer readable program code means configured for accessing said remote email server through network." This is responsively amended herein to read "wherein the communicating includes accessing *a* remote email server through *a* network" (emphasis added). Applicant contends this overcomes the rejection.

The Present Office Action states that there is no antecedent basis for "the email count" and "the current user" in "computer readable program code means configured for downloading the email count for the current user." The preamble of the claim is responsively amended herein to read "computer readable storage medium embodied therein for causing a computing system to access an email count." The body of the claim is responsively amended herein in similar fashion as the amendments discussed above regarding claim 1. Applicant contends this overcomes the rejection.

The Present Office Action states that there is no antecedent basis for "the display" in "computer readable program code means configured for displaying the email count for the current user in a defined format on the display." This is responsively amended herein to read "computer readable program code means configured for displaying the email count for the user in a defined format on *a* display" (emphasis added). Applicant contends this overcomes the rejection.

Other amendments to claim 7 are discussed herein below along with remarks regarding rejections under 35 U.S.C. 103(a).

Docket JP920000198U51

Appl. No.: 09/649,738

Filed: August 28, 2000

f. Claim 8

The Present Office Action states that there is no antecedent basis for "the TCP/IP protocol" in "communicating with the network adapter through the TCP/IP protocol." This is responsively amended herein to read "communicating with the network adapter through a TCP/IP protocol" (emphasis added). Applicant contends this overcomes the rejection.

g. Claim 9

The Present Office Action states that there is no antecedent basis for "the designated users" in "computer readable program code means for configuring the designated users." This is responsively amended herein to delete "the designated" in front of "users." Applicant contends this overcomes the rejection.

Other amendments to claim 9 are discussed herein below along with remarks regarding rejections under 35 U.S.C. 103(a).

4. Rejections under 35 U.S.C. 112, first paragraph

a. Sufficient description

The Present Office Action states that claims 1, 4 and 7 in the present application contain subject matter *not sufficiently described* in the specification of the application, i.e., not described in such a way as to reasonably convey to one skilled in the art that the inventor(s) had possession of the claimed invention at the time the application was filed. More specifically, the Present Office Action states, in essence, that the following aspects of the invention, according to the various forms in which they are claimed, are not sufficiently described:

downloading an email count for a current user from a remote email server on a network,
and

displaying the email count for the current user in a defined format on a display of a computing system.

The specification and drawings of the present application as originally filed teach the manner of using the invention in terms which clearly correspond in scope to the original claims used in describing and defining the subject matter sought to be patented. See present application, page 4, line 21 - page 5, line 2 and FIG's 1 and 2 (describing that BIOS downloads email headers via a network from a remote email system and then parses the headers to extract an email count for each designated user); page 5, line 2 (describing that the email count is displayed for

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

each designated users); page 3, line 26 (describing that the count is in a defined format on a display of a computing system); see also discussion in Appeal Brief, Summary of the Invention, page 2-3. (The specification uses both terms "designated user" and "current user" interchangeably. See, e.g., present application, page 3, line 26 (current user) and page 5, line 2 (designated user). To avoid confusion, Applicant herein amends the claims to use simply the term "user.") The specification also explains why the invention is useful. See present application, page 5, lines 5-15.

The Present Office Action rejects the claims as they were originally submitted. There is a strong presumption in favor of the applicant that the written description requirement has been met for claims submitted in an original application. Manual of Patent Examining Procedure 2163.I.A and 2163.II.A. It should be rare to reject an original claim for lack of written description. Manual of Patent Examining Procedure 2163.03.

Even in a case where the rejected claims are *not* the claims originally submitted, which is not as clearly favorable to the Applicant as the present case, the examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in Applicant's disclosure a description of the invention defined by the claims. Manual of Patent Examining Procedure 2163.04. In so rejecting a claim, the examiner must set forth findings of fact which support the conclusion that the written description is lacking. Manual of Patent Examining Procedure 2163.04.I. These findings should identify the claim limitations at issue and provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. *Id.*

While the Present Office Action has identified the claim limitations at issue, it does not provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Therefore, Applicant contends the Present Office Action fails to even meet the minimum burden needed to require Applicant to respond to the rejection. Nevertheless, without waiving Applicant's right to maintain that the Present Office Action has not made a *prima facie* case regarding lack of written description, Applicant presents the following reasons why the written description is adequate in the present case.

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

The issue with the written description requirement is not whether the claimed subject matter is described “in haec verba” in the specification, but merely whether it is described in a way “so that one skilled in the art can recognize what is claimed.” *University of Rochester v. G.D. Searle & Co., Inc.*, United States Court of Appeals for the Federal Circuit, 03-1304, decided February 13, 2004 (citing *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002)). This issue of describing the invention in a way that is not in the same words as in the specification arises at times because claims are amended after filing of a specification in order to distinguish an invention over prior art brought to the attention of applicants. See, e.g., Manual of Patent Examining Procedure 2163.03 (describing typical circumstances where adequate written description issue arises). Nevertheless, while permitting claims to differ from the language of the specification, the written description requirement dictates that the claims may not validly describe the invention more broadly than the supporting disclosure of the specification and drawings. See *Cooper Cameron Corporation v. Kvaerner Oilfield Products, Inc.* 291 F.3d 1317 (Fed. Cir. 2002) (explaining the court’s decision in *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998)).

The present case does not present a question whether the claims state the invention more broadly than permitted by the written description. Quite the contrary, in the present case, the original claims clearly describe what is claimed *in haec verba* in the original specification. In particular, the specification explicitly states exactly what is stated in the claims, that the “invention provides in a computing system . . . means to download the email count for the current user from the remote email server on said network, and . . . means to display the email count for the current user in a defined format on the display of said computing system.” Present application, page 2, lines 6 - 17. Further, the specification states that the “invention also provides in a computing system including a network adapter and a basic input/output system (BIOS) connected to a remote email server through a network, a method for accessing email count during the boot up process comprising . . . downloading the email count for the user from the remote email server on said network, and . . . displaying the email count for the current user in a defined format on the display of said computing system.” Present application, page 2, lines 24 - page 3, line 6. Further, the specification states that the “invention also provides computer readable program code means configured for downloading the email count for the current user

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

from the remote email server on said network, and . . . computer readable program code means configured for displaying the email count for the current user in a defined format on the display of said computing system. "Present application, page 3, lines 13 - 27. Since the specification of the present application clearly does describe what is claimed in the same words as the original claims, which stand rejected in the Present Office Action, the written description requirement is met without even presenting the question of whether the application states the claims in a manner that merely "reasonably conveys" to one skilled in the art that the inventor(s) had possession of these aspects of the invention at the time the application was filed. In addition, amendments submitted herein even further address any possible concern regarding adequacy of the written description in the present case. These amendments are discussed herein below along with the remarks regarding rejections under 35 U.S.C. 103(a).

b. Enablement

The Present Office Action also states that original claims 1, 4 and 7 in the present application contain subject matter *not enabled* by the specification of the application, i.e., not described in such a way as to enable one skilled in the art to make or use the invention. More specifically, the Present Office Action states that the same two elements, steps or limitations referred to herein immediately above are not enabled.

As explained herein above, the specification and drawings of the present application teach the manner of using the invention in terms which clearly correspond in scope to the claims used in describing and defining the subject matter sought to be patented. Also, the specification explains the usefulness of the invention. Accordingly, Applicant requests that the teaching of the disclosure be taken as in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, since no basis has been stated for doubting sufficiency of the teaching of the specification concerning an email count downloaded for a current user from a remote email server on a network, and the display of the email count for the current user in a defined format on a display of a computing system, as claimed. MPEP 2164.04 ("In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.”). Applicant has shown that the teaching of the specification corresponds in scope to the claims used in describing and defining the subject matter sought to be patented, Applicant has explained why this is useful, and no objective basis is propounded in the Present Office Action that gives rise to doubt regarding the teaching of the specification.

Further, the present invention involves software in many of its aspects. Present application, page 4, lines 16 - page 5, line 2 and FIG's 1 and 2 (describing BIOS, which is software). In the chemical arts and biological material arts, experimentation issues tend to arise due to the difficulty of practicing a claimed invention where a patent disclosure describes a chemical or biological material by its function.¹ Software, however, tends to be enabled by a mere description of its function. See *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997) (“As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed . . . Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.”); see also *Robotic Visions Systems, Inc. v. View Engineering, Inc.* 112 F.3d 1163 (Fed. Cir. 1997). In the present case, the functions of downloading an email count for a current user from a remote email server on a network, and displaying of the email count for the current user in a defined format on a display of the computing system are described in the specification and drawings as being controlled by BIOS, which is software.

In addition to the above reasons why the invention is enabled as originally claimed, amendments submitted herein even further address any possible concern regarding enablement in the present case. These amendments are discussed herein below, along with the remarks

¹ See, e.g., *University of Rochester v. G.D. Searle & Co., Inc.*, 03-1304 (Fed. Cir. 2004) (discussing how, in the biotechnology field, a “hoped-for function for an as-yet-to-be-discovered compound, and a research plan for trying to find it” is not a sufficient description for a claimed method where such a description does not disclose any compounds that can be used in the method, because such a claimed method cannot be practiced based on the patent’s specification, even considering knowledge of one skilled in the art); see also *Id.* (analyzing *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989 (Fed. Cir. 2000) and discussing how a sufficiently detailed functional description might enable an ordinarily skilled artisan to identify such a compound, where the description reflects the way the compound is actually formulated); see also *Id.* (analyzing *In re Edwards*, 568 F.2d 1349 (CCPA 1978) and discussion how a compound might be adequately described by a process of making the compound, rather than by its structure).

Docket JP920000198US!

Appl. No.: 09/649,738

Filed: August 28, 2000

regarding rejections under 35 U.S.C. 103(a) in part "b. Weight given to features set out in the preambles of the claims."

5. Rejections under 35 U.S.C. 103(a)

a. Issues about attacking references individually and combining references

The Present Office Action maintains the previous rejection of all claims under 35 U.S.C. 103(a), with reliance upon Khanna in view of Thurlow. In doing so, the Present Office Action merely repeats arguments made in the Final Office Action. Applicant has fully responded to these arguments at length in Applicant's former Appeal Brief. Applicant hereby reasserts the response of the Appeal Brief in its entirety, without repeating it.² In addition, in an effort to fully cooperate and communicate clearly, Applicant submits the following additional and rephrased remarks.

The Present Office Action takes issue with Applicant's analysis of the overall teaching of the two references, characterizing this as an improper attacking of the references individually. Applicant contends, however, that Applicant deviates from analyzing only the selected teachings relied upon in the rejection merely in an effort to consider *all* the teachings of the references, which is entirely proper. A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. MPEP Section 2141.03 (citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540). Applicant contends that in view of *all* the teachings of Thurlow, the references cannot teach or suggest the present invention as claimed.

The Present Office Action relies upon teachings by Thurlow to supply what the Office acknowledges is missing from Khanna, i.e., means to download email count for the current user from the remote email server on the network and means to display the email count for the current user in a defined format on the display of the computing system. However, in view of *all* the teachings of Thurlow it should be understood that in order to combine the teachings relied upon by the Present Office Action from Thurlow with the teachings relied upon by the Present Office Action from Khanna, the principle of operation taught by Thurlow would have to be dramatically changed and in a manner that is not workable. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified,

² By not herein setting out the full response again, Applicant does *not* waive the right to assert all of Applicant's arguments to the Board of Patent Appeals and Interferences.

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Thurlow includes teaching that is directly contrary to claim 1 of the present invention. That is, Thurlow teaches that email information is accessed "upon starting-up (i.e., boot)," *by an e-mail program, MICROSOFT OUTLOOK, not the BIOS*. Thurlow, Column 14, lines 34-57 ("LAN-Only Operation When the user has selected the LAN connection button 302 in the CCW 300 (FIG. 3), but has not selected the secondary dial-up network checkbox 304, the "MICROSOFT OUTLOOK '98" program will operate in LAN-only mode. This mode will never seek to establish a connection to the mail server 49 (FIG. 1), via a dial-up connection. Therefore, if the LAN connection is unavailable or the mail server 49 (FIG. 1) cannot be connected to via the LAN connection for some other reason, the program will simply be unable to enter the online mode of operation. Accordingly, *the "MICROSOFT OUTLOOK '98" program will check the LAN connection upon starting-up (i.e., boot)*. If the LAN connection to the mail server 49 (FIG. 1) is operational, then the program will send and receive mail via the LAN connection and then enter online mode. Periodically, the program will poll the mail server 49 (FIG. 1) in the background for any new incoming messages. . . .") (emphasis added). The reference by Thurlow to "upon starting-up (i.e., boot)" must be taken to mean that after the operating system loader takes over from the BIOS boot process the *email program* is loaded and checks the LAN connection, since Thurlow says "the 'MICROSOFT OUTLOOK '98' program will check the LAN connection upon starting-up (i.e., boot)." Thus, Thurlow teaches precisely the way of doing things that the present invention changes. The means of downloading an email count taught by Thurlow is *not compatible with downloading an email count during booting*, as claimed in the present application, since the downloading means taught by Thurlow is an email application program *that does not operate until the computer system has already been booted*.

b. Weight given to features set out in the preambles of the claims

The Present Office Action, states that in claim 1 the recitation "accessing the email information by the BIOS during the BIOS boot up process" has not been given patentable weight, based on the assertions that i) the recitation occurs in the preamble and ii) the claim preamble merely recites purpose or use of a structure and the body of the claim does not depend on the preamble for completeness. Applicant respectfully disagrees with both of these assertions. Applicant's reasoning in this regard has been fully explained in the Appeal Brief. No answer to Applicant's arguments has yet been provided.

Nevertheless, in an effort to fully cooperate and expedite an allowance despite Applicant's disagreement with the assertions, the claims are herein amended to explicitly state

Page 15 of 18

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

features in the bodies of the claims that were formerly stated in the preambles.³ Specifically, claim 1 has been amended to set out, in the body of the claim instead of the preamble, a processor, memory storage, input and output devices, a network interface adapter for connecting the computing system to a remote email server via a network, and a basic input/output system (BIOS). No new matter is added because these features were previously in the preamble as the claims were submitted in the original application. For the BIOS, the claim states the BIOS is "for booting the computing system." Originally, the BIOS was stated as being "for booting" in the preamble of the claim. Clearly, the BIOS is for booting *the computer system*, since the BIOS is in the computer system. See present application page 4, lines 22-23. Likewise, claim 4 is amended herein to set out, in the body of the claim, the step of "booting the computer system by the BIOS." And claim 7 is amended herein to state, in the body of the claim, that the BIOS includes the subsequently listed computer readable program code means.

Claim 1 is also herein amended to change "a means to communicate" so that it reads "communicating means for communicating." This is in order to provide a more clear antecedent basis for the following change. Claim 1 did set out "a means to access" a remote email server. This is herein amended to state that "the communicating means accesses the remote email server," since this is more consistent with the disclosure. See present application, FIG. 2 and page 4, lines 24-27 (describing that the BIOS uses the network adapter driver 2 and TCP/IP module 4 to communicate over the network for accessing an email system). Claim 1 also previously stated "a means to download" an email count. This is herein amended to state that "the communicating means downloads," since this is also more consistent with the disclosure about the network adapter driver 2 and TCP/IP module 4. The computer readable program code means configured for communicating is similarly amended in claim 7, for the same reasons.

In addition, claim 1 is amended herein to state that "the communicating means downloads "email headers," instead of an email count, and to set out that the BIOS includes "means for parsing the email headers during the booting of the computing system extract an email count for a user." No new matter is added, since the original specification and drawings provide support for the amendments. That is, as stated in the Detailed Description of the BIOS and shown in

³ By not herein setting out Applicant's full response from the Appeal Brief once again, Applicant does *not* waive the right to assert all of Applicant's arguments to the Board of Patent Appeals and Interferences.

Docket JP920000198US1

Appl. No.: 09/649,738

Filed: August 28, 2000

FIG. 2 of the present application, "The BIOS further uses the TCP/IP module (4) to communicate (11) with the remote email system over the network and access the email headers. The received email headers are then parsed (12) by email header parser (5) to extract the email count for each designated user." Present application, page 4, line 26 - page 5, line 1.

Claims 1, 4 and 7 are also amended herein to explicitly state that the accessing, downloading and displaying are all "during the booting of the computer system." No new matter is added, since the original specification and drawings provide support for the amendments. As stated in the Detailed Description of the present application, FIG. 1 shows that the BIOS 1 contains or includes, i.e., the network adapter driver 2, the TCP/IP module 4, email header parser 5 and display routine 6. Present application, page 4, lines 17-20. All the functions of the BIOS described in the Detailed Description of the present application and shown in FIG. 2 occur "when the computing system is switched on." Present application, page 4, line 22. This is quite clear when it is recognized that it is well-known the BIOS controls booting, which is done when a computing system is turned on and before other programs run. See www.foldoc.org definition of "bootstrap" ("To load and initialise the operating system on a computer. Normally abbreviated to "boot". . . The bootstrap loader is the program that runs on the computer *before any (normal) program can run.*") (emphasis added); see also www.foldoc.org definition of "BIOS" ("The part of the system software of the IBM PC and compatibles that provides the lowest level interface to peripheral devices and *controls the first stage of the bootstrap process*, including installing the operating system. The BIOS is stored in ROM, or equivalent, in every PC. Its main task is to load and execute the operating system which is usually stored on the computer's hard disk. . .") (emphasis added).

Claims 3, 6 and 9 are also amended herein to state that in a certain operation prior to the booting of the computing system users of the system are configured. This change is to more certainly state the claims in a clear manner, avoiding any possible indefiniteness for the term "previous" in the phrase "during a previous operation," which refers to an operation prior to the booting.

Applicant contends the above amendments eliminate the argument posited by the Present Office Action regarding weight given to the various features of the claim. Applicant further

Docket JP920000198US1

Appl. No.: 09/649,738

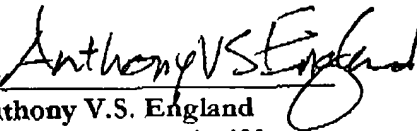
Filed: August 28, 2000

contends that these amendments and the arguments presented above overcome the prior art rejections.

REQUESTED ACTION

Applicant contends that the invention as claimed in accordance with amendments submitted herein is patentably distinct, and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

Respectfully submitted,

By 
Anthony V.S. England
Registration No. 35,129
Attorney of Record for
IBM Corporation
P.O. Box 5307
Austin, Texas 78763-5607
Telephone: 512-477-7165
a@aengland.com